



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,649	06/05/2001	Steven H. McCown	2001-025-SFT	5080
51344 7590 04/06/2007 BROOKS KUSHMAN P.C. / SUN / STK 1000 TOWN CENTER, TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238			EXAMINER ZAND, KAMBIZ	
			ART UNIT 2134	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/874,649

Applicant(s)

MCCOWN ET AL.

Examiner

Kambiz Zand

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 1-50 have been cancelled in response to Examiner Answer having a new ground of rejection.
4. New claims 51-68 have been amended in response to Examiner Answer having a new ground of rejection.
5. Claims 51-68 are pending.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but they are not persuasive.

As per applicant's arguments that none of the art disclose "storage device" associated with the requesting computer that is directly contacted by the server" page 5 of the response filed on 12/26/2006, examiner refers applicant to the following notes:

- "storage device" is nothing more than a medium that stores data (memory, hard-disk, cd's, dvd's, etc).

- Applicant on page 6 at least agrees that the two system are communicating to one another. Therefore the question is what this “direct” connection means between the server and the storage device. Davis does disclose that both system has processor, memory subsystem, and storage device (applicant agrees that Davis has a storage device, see last line of page 5 and the first paragraph of page 6 of the applicant response dated 12/26/2006). It is also inherent part of the computer architecture that processor and any other device including I/O interface devices, storage devices within a computer system talk to one another through the “BUS” system. Now it is also inherent that any communication between one computers to another through any I/O interfaces also must use the bus for carry data either in encrypted or clear text to the destination (please check any basic computer architecture from IBM, or other computer manufacturer for inherency support above). Therefore the phrase “direct” in the claim language is only interpreted in that context. Davis disclose having the storage device within the system, it also disclose communicating with other systems that has storage device. Therefore on any interpretation the direct link through the I/O bus exist.
- Examiner strongly suggests if the applicant invention is concentrated on direct link between the storage device and the server, such mechanism be part of the claim language in a manner that distinguishes it over prior art of the record. The claim language is broad enough that Davis and other prior art of records disclose such “direct” link.

Examiner would reconsider if “direct” link is specified in a manner that overcome the prior art as long as it does not raise new issue that need further consideration.

Claim Rejections - 35 USC § 102

7. **Claims 51-68** are rejected under 35 U.S.C. 102(b) as being anticipated by Davis

(6,292,892 B1).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claim 51 Davis (6,292,892 B1) teach a system for secure transmission of data over a public network (see fig.1-3 and associated text such as col.1, lines 34-45 disclose medium for transmitting data back and forth between parties connected in a network environment; col.2, lines 60-67; col.3, lines 1-9), the system comprising: a requesting computer connected to the network, the requesting computer requesting the secure transmission of data (see col.5, lines 66-67; col.6, lines 1-2 wherein the remote system random challenge transmission to the local system corresponds to applicant’s computer request for secure transmission);

A server connected to the network (see col.5, lines 66-67; col.6, lines 1-2 wherein the, the local system that corresponds to Applicant’s “server”), the server operative to encrypt the data requested by the requesting computer and transmit the encrypted data through the network;

A storage device associated with the requesting computer and connected to the network, the storage device operative to receive the encrypted data from the network, decrypt the received data, and store the decrypted data;

Art Unit: 2132

Wherein the server directly contacts the storage device over the network to establish an encrypted data channel between the server and the storage device, the encrypted data channel excluding the requesting computer (see col.6, lines 2-5, 56-62; col.4, lines 37-65, 58-63; col.1, lines 34-45; col.3, lines 37-55; col.5, lines 1-5;).

As per claim 62 Davis (6,292,892 B1) teach a method for securely transmitting data from a server over a public data transmission network (see col.5, lines 55-67; col.6, lines 1-2 the local system that corresponds to Applicant's "server", the method comprising:

Receiving a request from a client for transmission of requested data to a storage device directly connected to the network, the storage device associated with the client;

Negotiating an encrypted communications channel with the storage device through the network, the encrypted communications channel excluding the client;

Encrypting the requested data according to the negotiation with the storage device; and

Sending the encrypted data to the storage device through the network ((see col.6, lines 2-5, 56-62; col.4, lines 37-65, 58-63; col.1, lines 34-45; col.3, lines 37-55; col.5, lines 1-5;).

As per claims 53 and 64 Davis (6,292,892 B1) teach the method, the system as in claims 62, 51 respectively wherein the storage device sends a storage device public key to the server (see abstract where the public keys are outputted from one system to another and vice versa; also see the entire reference for other examples).

Art Unit: 2132

As per claims 54 and 65 Davis (6,292,892 B1) teach the method, the system as in claims 64, 53 respectively wherein the server sends a server public key to the storage device (see abstract where the public keys are outputted from one system to another and vice versa; also see the entire reference for other examples).

As per claim 55 Davis (6,292,892 B1) teach the system as in claim 51, wherein the secure transmission of data comprises at least one of audio data, and video data (see col. 5, lines 66-67; col.6, lines 1-2).

As per claim 56 Davis (6,292,892 B1) teach the system as in claim 51, wherein the storage device stores the data in a removable medium (see col.4, lines 66-67; col.5, lines 1--3 where PCMCIA card which is a removable storage).

As per claim 57 Davis (6,292,892 B1) teach the system as in claim 56, wherein the removable medium is one of a compact disc (CD) and a digital versatile disc (DVD) (see col.2, lines 64-67 disclose a CD).

As per claims 58 and 59 Davis (6,292,892 B1) teaches the system as in claim 56, teach the removable medium (see col.4, lines 66-67 and col.4, lines 1-10). However having it as is one of a tape cartridge and a tape cassette/ or one of a holographic disc and a holographic cube is only disclose the intended use and design choice. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the

Art Unit: 2132

prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Mash am, 2 USPO2d 1647 (1987)). The prior art is replete with references disclosing optical removable cards used to store information as applied to claims 6-7,24-25, 36-37 and 45-46 above.

As per claim 60 Davis (6,292,892 B1) teach the system as in claim 51, wherein the storage device is a solid-state storage device (see col.4, lines 1-10 disclose removable storage devices. Solid-state storage by definition is a nonvolatile, removable storage medium that employs integrated circuits rather than magnetic or optical media. It is the equivalent of large-capacity, nonvolatile memory, that is integrated hardware agent having a non-volatile memory 43 in a removable storage such as PCMCIA cards). Also A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPO2d 1647 (1987)). The prior art is replete with references disclosing optical removable cards used to store information as applied to claims 6-7,24-25, 36-37 and 45-46 above.

As per claim 61 Davis (6,292,892 B1) teach the system as in claim 51, wherein the storage device is independent of the client (see col.4, lines 66-67; col.5, lines 1-3 wherein the storage device may be implemented as a smart card (PCMCIA card) and therefore independent of the client system).

As per claim 66 Davis (6,292,892 B1) teach the method of claim 62 wherein negotiating an encrypted communication channel comprises receiving an encrypted master secret from the

Art Unit: 2132

storage device (see col.5, lines 66-67; col.6, lines 1-13 where the challenge represent applicant's secret).

As per claim 67 Davis (6,292,892 B1) teach the method of claim 66 further comprising decrypting the master secret using a server private key, wherein the master secret is encrypted by the storage device using a server public key (see col.5, lines 66-67; col.6, lines 1-13 where the challenge represent applicant's secret).

As per claim 68 Davis (6,292,892 B1) teach the method of claim 66 wherein encrypting the requested data comprises encrypting the requested data based on the received master secret (see col.5, lines 66-67; col.6, lines 1-13 where the challenge represent applicant's secret).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 52 and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (6,292,892 B1) in view of Dobner et al (6, 874,084 B1).

As per claims 52 and 63 Davis (6,292,892 B1) teach the method, the system as in claims 62, 51 respectively as applied above but do not disclose explicitly if SSL would be implemented for

Art Unit: 2132

secure transmission. However using SSL protocol is well known in the art as Dobner et al disclose in col.1, lines 38-64. It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize SSL protocol in Davis's method and system of communication in order to ensure the data transfer between the storage device and the server or other computers are kept secret (see col.1, lines 41-43).

10. **Claims 51-55 and 62-68** are rejected under 35 U.S.C. 102(e) as being anticipated by

Dobner et al (6,874,084).

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 51-55 and 62-68 Dobner et al (6,874,084) disclose all limitations of the above claims as outlined above in fig.1-7 and associated text; col.1, lines 37-col.3, lines 5 and 54-67; col.4-12.

11. **Claims 51-55 and 62-68** are rejected under 35 U.S.C. 102(e) as being anticipated by

Gillet et al (6,760,711).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 51-55 and 62-68 Gillet et al (6,760,711) disclose all limitations of the above claims as outlined above in fig.1-5 and associated text; col.3, line 19 through col.8, line 63.

12. **Claims 51-55 and 62-68** are rejected under 35 U.S.C. 102(e) as being anticipated by

Hallin et al (6,754,661).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 51-55 and 62-68 Hallin et al (6,754,661) disclose all limitations of the above claims as outlined above in fig.1-17 and associated texts.

13. **Claims 51-55 and 62-68** are rejected under 35 U.S.C. 102(e) as being anticipated by

Norris et al (6,754,678).

Art Unit: 2132

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 51-55 and 62-68 Norris et al (6,754,678) disclose all limitations of the above claims as outlined above in abstract; and fig.1-17 and associated texts.

14. Claims 51-55 and 62-68 are rejected under 35 U.S.C. 102(e) as being anticipated by

Wiser et al (6,868,403).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 51-52 and 62-63 Wiser et al (6,868,403) disclose all limitations of the above claims as outlined above in abstract; and fig.1-13 and associated texts.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2132

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

04/02/2007

AU 2134



KAMBIZ ZAND
PRIMARY EXAMINER